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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92058292
Party	Defendant Daniel S. Marolt
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8 **IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE**
9 **TRADEMARK TRIAL AND APPEAL BOARD**

10 In re: Registration No. 4398094 (CHICAGO BLUES HALL OF FAME)
11 Registered September 3, 2013

12
13 (The) Blues Foundation, Inc.

14 Petitioner,

15 v.

16 Dan Marolt,

17 Registrant.

CANCELLATION NO: 92058292

**ANSWER TO
PETITION FOR CANCELLATION**

18 Registrant/Defendant DANIEL S. MAROLT (MAROLT), pursuant to FRCP §8(b) and (c)
19 and other applicable law, Answers the unverified allegations the Petition for Cancellation
20 (Petition) filed by Plaintiff/Petitioner BLUES FOUNDATION, Inc. (BF) by admitting, denying, or
21 stating lack of knowledge or information sufficient to form a belief about the truth of allegations,
22 as follows:

- 23 1. Defendant MAROLT has insufficient information to form a belief about the truth of the
24 allegations of the introductory Paragraph of plaintiff's Petition stating that "(The) Blues
25 Foundation, Inc. ("Petitioner"), a Tennessee Non-Profit Corporation with a principal place of
26 business at 421 S. Main Street, Memphis, TN 38103."
27 2. Defendant MAROLT admits that portion of the introductory Paragraph of plaintiff's
28 Petition alleging that BF has petitioned the Trademark Trial and Appeal Board to cancel his mark.

1 3. Defendant MAROLT denies that portion of the introductory Paragraph of plaintiff's
2 Petition alleging that MAROLT's "Registration is for a mark which so resembles a mark that has
3 been previously used in the United States by Petitioner since at least as early as 1980 ("Petitioner's
4 Mark"), and not abandoned, as to be likely when used in or in connection with the services of the
5 applicant, to cause confusion, or to cause mistake, or to deceive."

6 4. Defendant MAROLT admits those portions of Paragraph 1 that allege the dates of filing by
7 MAROLT of his registration.

8 5. Defendant MAROLT denies that portion of Paragraph 2 of plaintiff's Petition alleging that
9 "Since 1980, Petitioner has maintained a Blues Hall of Fame that has become recognized as the
10 pre-eminent Blues Hall of Fame for recognizing outstanding Blues musicians. The Blues Hall of
11 Fame has inducted new members annually since 1980 for their historical contribution, impact and
12 overall influence on the Blues" in that Plaintiff's own exhibits show that its awards are not
13 commonly called the "Blues Hall of Fame," and any use of the term "Blues Hall of Fame" by
14 plaintiff BF is non-trademark use, and not use as a unique identifier of plaintiff's goods or
15 services.

16 6. Defendant MAROLT denies that portion of Paragraph 2 of plaintiff's Petition alleging that
17 "Blues Hall of Fame Introduction Web Page at Exhibit A" supports its allegations of preeminence
18 or priority of use of "Blues Hall of Fame" as a mark. Plaintiff's Exhibit A shows only current use
19 of phrase in non-trademark context.

20 7. Defendant MAROLT denies that portion of Paragraph 2 of plaintiff's Petition alleging that
21 "Hall of Fame Inductees by Year at Exhibit B (accessed at
22 https://blues.org/#ref=halloffame_inductees)" supports its allegations of preeminence or priority
23 of use of "Blues Hall of Fame" as a mark. Plaintiff's Exhibit A shows only current use of phrase
24 in non-trademark context.

25 8. Defendant MAROLT denies that portion of Paragraph 2 of plaintiff's Petition alleging that
26 "An article in the Winter 1980 Quarternotes publication (at Exhibit C) by the Department of
27 Music at Memphis State University (currently The University of Memphis) historical use of
28 Petitioner's Mark in 1980 by Petitioner, as well as recognition by third parties of its association

1 with Petitioner since the inception of the Blues Hall of Fame by the Petitioner." The article at
2 plaintiff's Exhibit C specifically refers to the awards ceremony as the "first National Blues Awards
3 show" and as the "Handys." The phrase "Blues Hall of Fame" is only used in non-trademark
4 context to list inductees, and its use by a third party only tends to show the descriptiveness of the
5 phrase.

6 9. Defendant MAROLT denies that portion of Paragraph 2 of plaintiff's Petition alleging that
7 "Exhibit D, Cleveland Plain Dealer, December 25, 1981 at 28" supports its allegations of
8 preeminence or priority of use of "Blues Hall of Fame" as a mark. Plaintiff's Exhibit D uses the
9 phrase "Blues Hall of Fame" once as a passing reference is only used in non-trademark context, by
10 a third party using the term descriptively.

11 10. Defendant MAROLT denies that portion of Paragraph 3 of plaintiff's Petition alleging that
12 the "use of Petitioner's Mark by Petitioner has been continuous since its first use in 1980" on
13 grounds including that BF did not use the phrase as a mark in commerce in exhibits it presented.

14 11. Defendant MAROLT denies that portion of Paragraph 3 of plaintiff's Petition alleging that
15 "Exhibit E (1985 The Blues Connection newsletter)" supports continuous use of the mark. The
16 article at plaintiff's Exhibit E specifically refers to the awards ceremony as the "National Blues
17 Awards Show," and the "Sixth Annual Blues Awards 'The Handys.'" The phrase "Blues Hall of
18 Fame" is only used in non-trademark context to list the inductees, by a third party descriptively.

19 12. Defendant MAROLT denies that portion of Paragraph 3 of plaintiff's Petition alleging that
20 "Exhibit F (Living Blues, March/ April 1990, at 6-7)" supports continuous use of the mark. The
21 phrase "Blues Hall of Fame" is only used in non-trademark context to list the inductees.

22 13. Defendant MAROLT denies that portion of Paragraph 3 of plaintiff's Petition alleging that
23 "Exhibit G (October 4, 1992 program from The Handys Blues Awards)" supports continuous use
24 of the mark. The phrase "Blues Hall of Fame" is only used in non-trademark context to list the
25 inductees. Exhibit G specifically refers to the awards ceremony as "The Handys Blues Awards"
26 with a big fat colorful logo to make its point clear.

27 14. Defendant MAROLT admits the allegation in Paragraph 4 that plaintiff's alleged "Mark"
28 has not been federally registered. MAROLT denies the remainder of the paragraph, and

specifically that the mark has been used in commerce by BF as mark, or has acquired distinctiveness in relation to plaintiff BF.

15. Defendant MAROLT admits the allegation in Paragraph 5 that on "August 2, 2013, Petitioner applied for registration of its mark "Blues Hall of Fame." MAROLT denies that the registration is for Serial No. 8602579.

16. Defendant MAROLT denies the allegations in Paragraph 6, and specifically that plaintiff BF has suffered any damage at all by MAROLT's use of his "Blues Hall of Fame" mark.

17. MAROLT as layman has insufficient information to form a belief about the truth of the allegations of Paragraph 7, which allegations solely contain statements regarding the law, rather than factual assertions.

18. MAROLT as layman has insufficient information to form a belief about the truth of the allegations of Paragraph 8, which allegations solely contain statements regarding the law, rather than factual assertions.

19. Defendant MAROLT denies the allegations of paragraph 9, including that plaintiff has suffered any damage by MAROLT's use of its mark, or that plaintiff has any rights to the mark, or has used continuously used the phrase as a mark in commerce.

20. Defendant MAROLT denies that portion of Footnote 2, Page 3, from Paragraph 9, alleging that MAROLT was aware of the plaintiff's "prior use of the mark" for reasons including that any prior use by plaintiff was not as a mark.

21. Defendant MAROLT has insufficient information to form a belief about the truth of the allegations in the remainder of Footnote 2, Page 3, from Paragraph 9, to the extent that they are averments of plaintiffs future intentions.

22. Defendant MAROLT denies the allegations of the "Wherefore" paragraph at the end of the Petition to the plaintiff claims it has been or will be damaged. MAROLT has insufficient information to form a belief about the truth of the allegations in the remainder of the paragraph in that they are averments of plaintiff's acts and desires.

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1 **AFFIRMATIVE DEFENSES**

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3 **FIRST AFFIRMATIVE DEFENSE**

4 **FAILURE TO STATE CLAIM**

5 Plaintiff has failed to state facts sufficient to support a claim on which relief can be
6 granted.

7 **SECOND AFFIRMATIVE DEFENSE**

8 **LACK OF STANDING**

9 Plaintiff lacks standing to bring the claims alleged in its Petition, and thus is not entitled to
10 relief thereon.

11 **THIRD AFFIRMATIVE DEFENSE**

12 **NON-TRADEMARK USE BY PETITIONER**

13 Plaintiff has not, prior to the use by defendant MAROLT, utilized the mark as a unique
14 identifier of its goods and services, as shown by plaintiff's own exhibits and as alleged herein.

15 **FOURTH AFFIRMATIVE DEFENSE**

16 **LACK OF SECONDARY MEANING**

17 Plaintiff has not pled and cannot show that its purported use of the phrase "Blues Hall of
18 Fame," to the extent it could be considered trademark use, which MAROLT denies, has acquired
19 secondary meaning such that the descriptive phrase could be protected at common law or
20 otherwise.

21 **FIFTH AFFIRMATIVE DEFENSE**

22 **NON-FAMOUS MARK**

23 Plaintiff's use of the phrase "Blues Hall of Fame" to the extent it could be considered
24 trademark use, which MAROLT denies, does not rise to the very high threshold required to prove
25 that the phrase as applied to plaintiff is "famous" as the term is defined by law.

26 **SIXTH AFFIRMATIVE DEFENSE**

27 **NO PRIORITY OF USE**

28 Plaintiff does not have priority of use of the "Blues Hall of Fame" mark.

1 **SEVENTH AFFIRMATIVE DEFENSE**

2 **DIFFERENT CLASSIFICATION OF GOODS AND SERVICES**

3 Plaintiff appears to claim its right to the "Blues Hall of Fame" on the basis of use for its
4 "Handys" awards honoring blues musicians, and/or for inductees to its list of blues musicians.
5 (Defendant is unclear on this based on allegations of the Petition.) The Goods and Services
6 classification of MAROLT's "Chicago Blues Hall of Fame" is International Class 35, "On-line
7 retail store services featuring books, CDs, shirts, hats, posters and musical equipment concerning
8 blues musicians all related to an open organization dedicated to honoring and inducting blues
9 musicians and organizing induction ceremonies at live blues shows," and thus is a different
10 classification than that apparently claimed by plaintiff BF.

11 **EIGHTH AFFIRMATIVE DEFENSE**

12 **NO LIKELIHOOD OF CONFUSION**

13 Due to the different uses of the term "Blues Hall of Fame," by plaintiff BF, and "Chicago
14 Blues Hall of Fame" by defendant MAROLT, to the extent plaintiff's use could be considered
15 trademark use, which MAROLT denies, there exists no likelihood of confusions in the public
16 regarding the respective uses by the parties of the phrase.

17 **NINTH AFFIRMATIVE DEFENSE**

18 **BAD FAITH**

19 Plaintiff's petition is not that of a trademark holder trying to assert priority over a mark. It
20 is the petition of a bully attempting to wield its power over a smaller organization – an
21 organization about which plaintiff has been fully aware for up to 13 years – in order to now obtain
22 rights to a mark which it apparently did not care about before. A smaller entity who poses no
23 threat to plaintiff BF in that they serve different functions. MAROLT's organization is an open
24 society that predominantly recognizes small-time "local" blues musicians – those who toil for
25 years in small bars; those who are loved and nominated by their local fans; and who receive
26 recognition by MAROLT's Blues Hall of Fame through certificates, awards, and shows (and who
27 often are reduced to tears of gratitude). Plaintiff's Blues Foundation is an opaque, closed society
28 of unknown persons who nominate only the most well known and established of blues musicians

1 to their organization, which MAROLT is informed and believes requires paid membership in said
2 organization.

3 MAROLT is informed and believes by both written and oral communications with
4 executives and others on behalf of plaintiff, that plaintiff BF has known of MAROLT's domains
5 and websites, and specifically BluesHallofFame.com, for about 13 years, as well as MAROLT's
6 ChicagoBluesHallofFame.org, for about two years. BF and a representative of MAROLT's
7 organization met in about 2008 to discuss potentially working together, on the premise stated by
8 BF's Executive Director of doing what is best for the blues community; BF again approached
9 MAROLT in 2011 stating specifically in writing that "The Blues Foundation wants to be able to
10 use the term Blues Hall of Fame without being in violation of the law." And in the spirit of
11 cooperation and the betterment of the blues community, MAROLT agreed to license the "Blues
12 Hall of Fame" mark to plaintiff BF, in perpetuity, for the total cost of the \$300.00 MAROLT paid
13 to have an attorney draft the license itself. After delivering the license to plaintiff, plaintiff
14 declined to agree to the virtually-free license to utilize the "Blues Hall of Fame" mark, but instead
15 threatened MAROLT with a lawsuit for trademark infringement, etc.

16 In late 2012, a member of plaintiff's Board of Directors told MAROLT that plaintiff
17 wanted to purchase the "Blues Hall of Fame" mark. That Director put MAROLT in contact with
18 another Director for BF, who was represented to be an attorney with mediation experience. That
19 attorney Director advised MAROLT to open negotiations with a high asking price for the "Blues
20 Hall of Fame" mark, to leave room for negotiation downward. As such, MAROLT considered the
21 time and years he and so many others had put into the "Blues Hall of Fame" organization and
22 websites, and in early 2013 made a fairly substantial opening offer to sell the "Blues Hall of
23 Fame" mark. That offer was promptly taken off the table by BF.

24 Around that same day, multiple musicians sent MAROLT's organization emails requesting
25 that they be removed from MAROLT's website – at least one of which emails was also CC'd to the
26 Executive Director for plaintiff Blues Foundation, Jay Sieleman (also an attorney).

27 MAROLT is informed and believes, based on oral and written representations and
28 evidence, that BF embarked on a campaign of pressuring blues musicians with any connection to

1 plaintiff's organization to avoid, and in some cases cease all affiliation with MAROLT's
2 organization. Many musicians have since declined opportunities and engagements with
3 MAROLT's Blues Hall of Fame – several apologetically – citing the wishes of plaintiff BF as the
4 reason.

5 Plaintiff's act, including that of bringing this action, constitute bad faith in that it had
6 myriad opportunities to achieve its purported goal of the betterment of the blues community, and
7 use of MAROLT's "Blues Hall of Fame" mark for nearly free, but instead chose the legal route,
8 and appears not to give a lick about the majority of blues musicians – only their cloistered group
9 of famous players, and the attempted monopoly of its own organization at the expense of the
10 musicians themselves.

11 Plaintiff Blues Foundation, Inc. is a bully. It apparently believes that a position of power
12 and superior resources function as a substitute for the merits of its case. Plaintiff is acting in bad
13 faith in this claim, and recovery should be denied for its bad faith and unclean hands.

14 **TENTH AFFIRMATIVE DEFENSE**

15 **UNCLEAN HANDS**

16 MAROLT is informed and believes, based on written and oral representations and
17 evidence, that BF embarked on a campaign of pressuring blues musicians and related parties
18 having any connection to plaintiff's organization to avoid, and in some cases cease all affiliation
19 with MAROLT's organization. Many musicians have since declined opportunities and
20 engagements with MAROLT's Blues Hall of Fame, citing the wishes (translation: threats) of
21 plaintiff BF as the reason.

22 Plaintiff BF, aware of MAROLT's use of the "Blues Hall of Fame" mark and identical
23 websites at blueshalloffame.org and blueshalloffame.com for over a decade, did not object, but
24 indeed tacitly approved of defendants' activities by failure to take action. Plaintiff BF has also
25 been aware of MAROLT's ChicagoBluesHallofFame.org, for about two years.

26 Only later, when plaintiff BF began efforts to open a physical venue they wanted to call
27 "Blues Hall of Fame" did plaintiff approach MAROLT regarding potential use of his "Blues Hall
28 of Fame" mark. Yet, when given the opportunity to use the mark, in perpetuity, for virtually fee,

1 BF declined. Instead, it took action to harm MAROLT's organization by acts including
2 pressuring third parties not be work with defendant, or even be listed on defendant's websites. As
3 such, BF comes to this claim with unclean hands, in representing to MAROLT on the one hand
4 that it wants to work with him, and simultaneously interfering with his operations by pressuring
5 blues artist associated with plaintiff to sever ties to MAROLT's Blues Hall of Fame.

6 **ELEVENTH AFFIRMATIVE DEFENSE**

7 **ESTOPPEL**

8 Plaintiff's acts, and its failure to act as alleged herein, in regard to its claimed rights, are
9 sufficient to constitute estoppel, thus barring any right of action by plaintiff at this time.

10 **TWELFTH AFFIRMATIVE DEFENSE**

11 **WAIVER**

12 Plaintiff's acts, and its failure to act as alleged herein, in regard to its claimed rights, are
13 sufficient to constitute waiver, thus barring any right of action by plaintiff at this time.

14 **THIRTEENTH AFFIRMATIVE DEFENSE**

15 **LACHES**

16 Plaintiff's knowledge of defendant MAROLT's mark and use of the mark for up to 13
17 years; its communications with MAROLT or his associates regarding the mark as long as five
18 years ago; and its communications regarding nearly-free licencing of the mark nearly three years
19 ago, and thereafter, including threats of litigation not acted upon, and other facts as alleged herein,
20 raise the defense of laches in that the rights now claimed by plaintiff are alleged rights on which it
21 slept for over a decade. Plaintiff is therefore barred from recovery by the doctrine of laches.

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1 **PRAYER**

2 Defendant MAROLT therefore prays that plaintiff obtain no relief by its Petition, and that
3 the board grant MAROLT relief as is just.

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5 Dated: January 6, 2014

6 
T.C. Johnston, attorney for Daniel S. Marolt

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DECLARATION OF SERVICE

I, T.C. Johnston, declare that I am, and was at the time of service of the papers herein referred to, over the age of eighteen years, and not a party to the action; and I am employed in the County of San Diego, California, in which county the within-mentioned mailing occurred. My business address is 3245 University Ave., Suite 1245, San Diego, CA 92104; info@tcjohnston.com. I served the following documents: **ANSWER TO PETITION FOR CANCELLATION** by emailing a copy to the following parties pursuant to written agreement of the parties:

Adam J. Eckstein, Esq
MARTIN, TATE, MORROW & MARSTON, P.C.
6410 Poplar Avenue, Suite 1000
Memphis, TN 38119-4839
Email: aeckstein@martintate.com

I declare under penalty of perjury under the laws of the United States and State of California that the foregoing is true and correct to the best of my knowledge and belief.

Executed on at San Diego, California.

DATED: January 6, 2014


T.C. Johnston